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9

Remarks

Applicants hereby add new claims 36-42 and cancel claims 9, 27-28 and 33. Accordingly, claims 1-8, 10-15, 21-26, 29-32, and 34-42 are pending in the present application.

Claims 1-2 and 21-35 stand rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 5,671,282 to Wolff et al. Claims 3-5, 7-10, 13-15 and 33 stand rejected under 35 USC 103(a) for obviousness over Wolff in view of U.S. Patent No. 5,987,127 to Ikenoue et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to independent claim 1, the method recites limitations which correspond to dependent claim 33 which was rejected over Ikenoue and Wolff. Applicant respectfully submits that the combination of Ikenoue and Wolff is improper for the below-mentioned reasons and claim 1 is allowable over the prior art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 3).

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness*. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to **provide some suggestion of the desirability of doing what the inventor has done**. MPEP §2142 (8th ed., rev. 3).

Applicants respectfully submit the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

Case No. 10982225-2
S/N: 10/636,726
Amendment A

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority*. The Court also stated that *deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed*. The Court further stated that *the determination of patentability must be based on evidence*. MPEP 2143.01 (8th ed., rev. 3) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.

On page 5 of the Action in support of the 103 rejection of claim 33, the Office states that the combination of Ikenoue and Wolff is appropriate "in order to prevent illegal copying." Applicant respectfully submits that the motivational rationale identified by the Office is insufficient and the Office has failed to meet its burden of establishing a proper 103 rejection.

More specifically, the Examiner relies upon col. 1, line 12-15 of Ikenoue in support of the motivation to combine the references. These teachings are concerned with preventing illegal copying (e.g., copyright infringement or making illegal copies of secret documents per col. 1, lines 17+ of Ikenoue). However, these teachings indicate problems to which Ikenoue is directed to solve and the Office has failed to point to any objective evidence that the system of Wolff would benefit from the combination to motivate one of skill in the art to combine the reference teachings as set forth in the 103 rejection.

Furthermore, Wolff already provides a solution for which Ikenoue is presented. In particular, at col. 10, lines 50+, Wolff explicitly discloses documents including information which encodes information about who can make copies and

Case No. 10982225-2

S/N: 10/635,726

Amendment A

copiers *would require an authentication code or card* before permitting the duplication of a document in an entirely different manner than the claimed limitations of determining whether copying is permitted using information of the comparing. The teachings of Ikenoue relied upon by the Office are redundant to the already disclosed teachings of Wolff and there is no motivation to combine the teachings of Ikenoue with the teachings of Wolff. The Office has recited no objective rationale as to whether the teachings may be combined at all let alone why the teachings of Ikenoue would provide any benefit to the disclosed arrangements of Wolff. Applicant respectfully submits it is inappropriate to rely upon another reference for a solution to a problem when the reference being modified already provides a solution to the problem for which the other teaching is provided.

The cursory motivational rationale set forth on page 5 of the Office is insufficient to motivate one to combine the reference teachings. Also, the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01III (8th ed., rev. 3) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990).

In sum, there have been no deficiencies of the primary reference identified by the Office to motivate one to look to another reference for meaningful corrective teachings. There is no evidence of record that the primary reference being modified suffers from any deficiencies or that any deficiencies in the art would be solved by the combination proposed by the Office. There is no evidence of record that any improved operations of the prior art would result from the combination proposed by the Office. The only motivational rationale provided by the Office is unsupported and conclusory and/or improperly based upon Applicants' own teachings. The Office has failed to establish proper motivation for at least the above-mentioned compelling reasons and Applicants request withdrawal of the 103 rejection in the next Action.

The claims which depend from independent claim 1 are in condition for

Case No. 10982225-2

S/N: 10/635,726

Amendment A

allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to the rejection of dependent claim 5, the Office states on page 5 of the Action that Wolff col. 5, lines 50-63 discloses that information included in the code includes a storage location of a file. Applicant respectfully disagrees. The identified teachings merely state that the encoded information includes an identifier, version number, date and other relevant information to identify the human readable portion of the document. These teachings fail to mention file or the positively recited limitations of the information including a storage location of a file corresponding to the document. Positively recited limitations of the claims are not taught by the prior art even if the teachings of Ikenoue are combined with the teachings of Wolff and the Office has failed to meet its burden of establishing a prima facie 103 rejection for at least this additional reason.

Referring to independent claim 6, the method includes the limitations of previously pending claim 9 which was rejected under 103. Applicant respectfully submits there is insufficient motivation to combine the reference teachings in support of the rejection and the Office has failed to meet its burden of establishing a proper prima facie rejection.

In particular, as discussed above, the rationale in support of the rejection of claim 9 provided by the Office on page 5 of the Action is insufficient and the 103 rejection of claim 9 relying upon the same faulty rationale is improper.

In addition, as set forth in col. 8, lines 59+ of Wolff, document change detection details which insure that no change has been made to a document are described. The procedure enables security by providing correspondence between machine readable information such as a bar code and the human interpretable information it accompanies. There is no reasonable expectation of success of modifying Wolff to arrive at claim 6 as proposed by the Office while preserving the ability of Wolff to implement the document detection details. Furthermore, the defeating of explicitly disclosed features of Wolff teaches away from the combination proposed by the Office. In view of MPEP 2141.02VI (8th ed., rev. 3), prior art references must be considered in their entirety including disclosures that

*Case No. 10982225-2
S/N: 10/635,726
Amendment A*

teach away from the claims. Applicant submits the teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Also, even if the references are combined, positively recited limitations of claim 6 are not disclosed nor suggested by the prior art and claim 9 is allowable for this additional reason. Claim 6 recites the machine-readable code is configured *such that it will not be fully reproduced on any copies formed by copying the original document with the second copying machine*. The Office has failed to point to any teachings of the prior art which allegedly disclose or suggest the above-recited limitations of claim 6 (previously recited in claim 9). Claim 6 is allowable for this additional reason.

The claims which depend from independent claim 6 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 11 stands rejected over Jeran. Jeran is the parent application of this continuation application. This continuation application claims priority to Jeran and Applicant respectfully submits the rejection of claim 11 is improper. Applicant requests issuance of a non-final Action if claim 11 is not allowed so Applicant may appropriately respond during the prosecution of this application.

Claim 29 stands rejected for alleged anticipation over Wolff. However, MPEP §2131 (8th ed., rev. 3) states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). The Office relies upon col. 5, lines 32-44 of Wolff as allegedly disclosing the claimed providing the database and the determining. However, these teachings of Wolff merely state that a single electronic version of each document is stored. The teachings are absent of any disclosure or suggestion of the claimed *providing the database comprising the*

Case No. 10982225-2
S/N: 10/635,726
Amendment A

plurality of digital representations of a plurality of different versions of the document including first and other versions, or the claimed determining the presence of the digital representation of the other version of the document using the extracted information as claimed. Positively-recited limitations are not disclosed nor suggested by the prior art and claim 29 recites allowable subject matter for at least this reason.

The claims which depend from independent claim 29 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 32, the system recites limitations of claim 33. The Office relied upon the teachings of Ikenoue in combination with the teachings of Wolff in support of the rejection. However, the Office has failed to establish a *prima facie* 103 rejection of claim 33 inasmuch as there is no motivation to combine the reference teachings in support of the rejection of claim 33. Applicant respectfully submits that claimed 32 is allowable for at least this compelling reason.

The claims which depend from independent claim 32 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants have identified herein numerous claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable.* Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to

Case No. 10982225-2
S/N: 10/635,726
Amendment A

15


37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Applicant hereby adds new claims 36-42 which are supported by Fig. 1 and at least at page 4, lines 22+ and at page 6, lines 5+ of the originally-filed specification.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
Paul Jeran et al.

By: 
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Date: 7/20/06

Case No. 10982225-2
S/N: 10/635,726
Amendment A